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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,152	03/29/2001	Kenneth A. Parulski	75276BPRC	4844

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EXAMINER

WILSON, JACQUELINE B

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,152

Applicant(s)

PARULSKI ET AL.

Examiner

Jacqueline Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-21 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 03/29/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/29/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 6, 7, 17, 20, 21, 22, and 23 of Parulski et al U.S. Patent No. 6,573,927 in view of Wilska (US 6,427,078).

Regarding Claims 1 and 2, Parulski et al teaches in claim 1 an image sensor, an analog-to-digital converter, a removable memory card, an internal memory, a processor, a display, and a user interface. Although Parulski et al claims transferring images to be printed, Parulski et al does not teach storing a plurality of e-mail addresses in which images are transferred to a selected e-mail address. Wilska teaches a notebook computer, which includes an electronic camera, stores a phone list for easy selection of recipient information (col. 7, lines 54+). The phone list includes address file information such as telephone numbers, telefax, or e-mail addresses (col. 7, lines 65+). Thus when

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the user is ready to transmit data, selection of the desired location may be obtained. It would have been obvious to use this teaching in Ward et al for the purpose of maintaining desired e-mail address for transmitting information. Therefore, it would have been obvious to one having ordinary skill in the art to modify Ward et al by permitting the memory (28) to have pre-stored e-mail addresses for easy accessing of desired destinations.

Furthermore, Parulski et al teaches the user interface enables selection of particular digital image files to be printed and the utilization files further includes the names of at least one digital image file to be printed by a separate printing device.

Regarding Claim 3, Parulski et al fails to claim a communications interface which interfaces to a communications network for transferring the selected digital image files to the at least one selected e-mail address. However, Wilska teaches a transmitter (antenna 18 and cellular mobile telephone and modem 17) for transmitting images to a remote location via e-mail addresses. This permits the user to deliver information wirelessly to desired recipients. Therefore, it would have been obvious to one having ordinary skill in the art to include a communications network for transferring the selected digital images to the at least one selected e-mail address.

Claims 4 and 5 are analyzed and discussed with respect to Claim 3. (See rejection of Claim 3 above.)

Regarding Claim 6, Parulski et al fails to claim a send command to initiate transfer of the selected digital image files to the at least one selected e-mail address using the transmitter. However, Wilska teaches using a keypad or a pen on a digitizer

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pad for issuing a command to transmit information (col. 8, lines 5-18). This is performed for the purpose of sending the desired information to the selected recipient. This provides accurate transmission of information to the appropriate destination. Therefore, it would have been obvious to one having ordinary skill in the art to use a send command to initiate transfer of the selected digital image files to the at least one selected e-mail address using the transmitter.

Regarding Claims 7 and 8, Parulski et al fails to claim a separate docking unit having a modem for transferring the selected digital image files to the at least one selected e-mail address. Wilska teaches a modem (17) for sending selected images to e-mail addresses. Once the image is chosen and transmitted, a network or service provider inherently receives the information (since it is done using the internet) and delivers the images to the specified e-mail address. This allows for effective transmission to desired e-mail addresses for viewing images. The modem is interpreted as a "docking unit" since it is coupled for transmitting data to the service provider. Therefore, it would have been obvious to one having ordinary skill in the art to include a separate docking unit having a modem for transferring the selected digital image files to the at least one selected e-mail address.

Regarding Claim 9, Parulski et al teaches in Claim 4 the utilization file further includes the file type of each digital image file.

Regarding Claim 10, Parulski et al teaches in Claim 5 the file type of at least one digital image file is a JPEG file type.

Regarding Claim 11, Parulski et al teaches in Claim 6 the utilization file further includes a camera owner name and a mailing address of such camera owner.

Regarding Claim 12, Parulski et al teaches in Claim 7 the utilization file includes a credit card number of the camera owner.

Claims 13 and 14 are a method claim of Claims 1 and 2 in which Parulski et al teaches in Claim 17. Therefore, Claims 13 and 14 are analyzed and discussed with respect to this claim. (See rejection of Claims 1 and 2 above.)

Claim 15 is analyzed and discussed with respect to Claim 3. (See rejection of Claim 3 above.)

Claim 16 is analyzed and discussed with respect to Claim 5. (See rejection of Claim 5 above.)

Claim 17 is analyzed and discussed with respect to Claim 8. (See rejection of Claim 8 above.)

Regarding Claim 18, Parulski et al teaches in Claim 20 the utilization file further includes the file type of each digital image file.

Regarding Claim 19, Parulski et al teaches in Claim 21 the file type of at least one digital image file is a JPEG file type.

Regarding Claim 20, Parulski et al teaches in Claim 22 the utilization file further includes a camera owner name and a mailing address of such camera owner.

Regarding Claim 21, Parulski et al teaches in Claim 23 the utilization file includes a credit card number of the camera owner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline Wilson whose telephone number is (703) 308-5080. The examiner can normally be reached on 8:30am-5:00pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on (703) 305-4929. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JW
12/01/04



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